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STEIN MCEWEN, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON, DC 20005

EXAMINER	
FISCHER, ANDREW J	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNG-KWON HEO

Appeal 2009-009104
Application 09/960,504
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 5-7, 9, and 34-42. Claims 1-4, 10-33, and 43-46 have been allowed and claim 8 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to an apparatus and method to transcopy data (Spec. [0004]). Claims 5 and 7, reproduced below with the numbering in brackets added, are representative of the subject matter of appeal.

> 5. A content data structure stored on a recordable medium, the content data comprising:
>
> content data comprising one of original and copied content data;
> [1] data file information unique to said content data so that said content data is distinguishable by a recording and/or reproducing apparatus from other content data, [2] said data file information comprising information used by the recording and/or reproducing apparatus to determine the corresponding original content data in the case that the content data is the copied content data; and
>
> [3] a rights management information area to indicate to the recording and/or reproducing apparatus whether said content data is the original content data or the copied content data transcopied from the original content data such that the recording and/or reproducing apparatus distinguishes between the original and copied content data,

[4] and to indicate to the recording and/or reproducing apparatus rights information related to the recording and/or reproducing apparatus performing data transcopying of said content data,

wherein said rights management information for the original content data and the copied content data changes according to transcopying situations.

7. A method for transcopying data, the method comprising:

confirming an original coding method applied to original content data;

setting a different coding method than the original coding method; and

converting the original content data to generate copied content data to be decoded by the different coding method;

wherein said converting the original content data comprises recording information indicating that the original content data was transcopied into the copied content data is recorded in a rights management information area of the original content data, and recording information indicating that the copied content data was transcopied from the original content data in a rights management information area of the copied content data.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 5-7, 9, and 34-42 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

THE ISSUES

With regards to claims 5-6, the issue turns on whether claim 5 is directed to content data. With regards to claims 7 and 9, the issue turns on whether the claims are directed to an abstract idea. With regards to claims

34-42 the issue turns on whether claim 34 is broad enough to cover a transitory propagating signal.

ANALYSIS

Claims 5-6 and 34-42

The Examiner has determined that the rejection of claims 5-6 and 34-42 is proper under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Ans. 3). Specifically, the Examiner cites that these claims contain abstract ideas, non-functional descriptive material (Ans. 3-4), and mere collections of data (Ans. 7).

In contrast, the Appellant argues that for claims 5-6 and 34-42 that the Examiner has failed to provide a prima facie case that the cited claims contain "non-functional descriptive material" (Br. 6). The Appellant for instance states that in claim 5, that claim limitations [1] and [4] contain "descriptive material" which address functional relationships in the claim (Br. 8).

We agree with the Examiner. Turning first to claim 5, the claim preamble recites "A content data structure stored on a recordable medium, *the content data comprising*" (emphasis added) and the claim is merely directed to data, not a structure positively recited on a recordable medium as the preamble is not a limitation to the claim here. A claim drawn to a mere data structure is not patentable under 35 U.S.C. § 101 (see *In re Wamerdam*, 33 F.3d 1354 at 1358). Regardless, a further analysis of claim 5 shows the claim limitations [1] and [4] cited by the Appellant to be non-functional descriptive material as they are essentially only "data file information" and "rights management information" directed to data. For these reasons the

rejection of claim 5, and dependent claim 6 not separately argued, is sustained.

The Appellant has provided essentially the same arguments for claims 34-42. Claim 34 is drawn to "A computer-readable medium encoded with data that is readable by a computer". Here, the claim covers forms of non-transitory tangible media and transitory propagating signals. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuitjen*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007). Regardless, for similar reasons as mentioned above, the claim limitations cited by the Appellant are "non-functional descriptive material" as they are drawn to mere data in "identification information" and "rights information". For these above reasons, the rejection of claim 34, and claims 35-42 not separately argued, is sustained.

Claims 7 and 9

The Examiner has also rejected claims 7 and 9 under 35 U.S.C. § 101 in a new grounds of rejection and applied a "machine or transformation" test analysis (Ans. 5). In contrast, the Appellants have argued that claim 7 recites patentable subject matter because the original data is transformed in the claimed process (Reply Br. 7-8) and because the method is tied to a specific machine (Reply Br. 8-9).

We agree with the Examiner. Claim 7 is a method claim drawn to "A method of transcopying data". The claim is drawn simply to an abstract idea of converting data without any significant post-solution activity to tie it to a particular machine. Regardless, for similar reasons as mentioned above, the

claim limitations cited by the Appellant as drawn to "non-functional descriptive material" as they are drawn to mere data. For these reasons, the rejection of claim 7, and claim 9 which not been separately argued, is sustained.

CONCLUSIONS OF LAW

We conclude that the Examiner not erred in rejecting claims 5-7, 9, and 34-42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The Examiner's rejection of claims 5-7, 9, and 34-42 is sustained.

AFFIRMED

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STEIN MCEWEN, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON DC 20005